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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,774	10/12/2005	Bernhard Gleich	DE 030117	2136

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BRIARCLIFF MANOR, NY 10510

EXAMINER	
GUPTA, VANI	
ART UNIT	PAPER NUMBER
3768	
MAIL DATE	DELIVERY MODE
09/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/552,774	GLEICH ET AL.	
	Examiner	Art Unit	
	VANI GUPTA	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/12/05; 3/5/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1 – 9 and 19 – 20 in the reply filed on June 8, 2009 is acknowledged.

2. Applicant's cancellation of claims 10 – 18 and 21 - 34 without predjudice in the reply filed on June 8, 2009 is acknowledged.

Claim Rejections - 35 USC § 101

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. ***Claims 1 and 5 – 7 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 – 5 of U.S. Patent No. US 7,351,194 B2,***

in view of Kraus, JR. et al. (US 6,479,220 B1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to one of ordinary skill in the art that claim 1(a) – 1(d) of the conflicting patent is the same as Claim 1(a) of the present application; and that the modes of operations for changing the position of the two sub-zones of part 1(e) of the conflicting patent would achieve the same results as the means for generating mechanical displacement near or in the area of examination.

It would also be obvious to one of ordinary skill that when the region is heating up, the particles within the area would vibrate, resonate, or "oscillate," or periodic changes in flow direction (Kraus: col. 9, line 52 – col. 10, line 21).

Claims 5 – 7 of the present application covers the same subject matter of claims 3 – 5 of the conflicting patent.

2. ***Claims 1, 5, 6, 8, and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 50, 52, 53, 55, and 56 of copending Application No. 10/552.812 in view of Kraus, JR. et al. (US 6,479,220 B1).*** Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to one of ordinary skill in the art that an area with low-magnetic field strength would comprise magnetic particles in a non-saturated state and an area with high-magnetic field strength would comprise magnetic particles in a saturated state.

It would also be obvious to one ordinary skill in the art that detection and analysis means of the conflicting claims comprises narrower features that would comprises the broader features of Claim 1 of the present application (Kraus: col. 6, line 41 – col. 7, line 10).

Claims 5, 6, 8 and 9 of the present application covers the same subject matter of claims 52, 53, 55 and 56 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re* Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. ***Claims 1 – 9, 19, and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kraus, JR. et al. (US 6,470, 220 B1).***

Regarding Claim 1, Kraus, JR. et al. (hereinafter Kraus) discloses a device for determining mechanical, particularly elastic, parameters of an examination object, comprising

a) at least one arrangement for determining the spatial distribution of magnetic particles in at least one examination area of the examination object, further comprising a means for generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in at least one examination area a first part-area having a low magnetic field strength

and a second part-area having a higher magnetic field strength, a means for detecting signals ("SQUID," col. 7, ll. 60 – 67) which depend on the magnetization in the examination object, particularly in the examination area, that is influenced by a spatial change in the particles, and a means for evaluating the signals so as to obtain information about the, in particular temporally changing, spatial distribution of the magnetic particles in the examination area (col. 13, ll. 9 – col. 14, line 36); and

b) at least one means for generating mechanical displacements ("magnetocarcinotherapy (MCT)," col. 3, ll. 52 – 60), in particular oscillations, at least in and/or adjacent to the examination area of the examination object (col. 9, line 23 – col. 10, line 21; col. 13, line 15 – col. 14, line 25).

Regarding Claim 2, Kraus discloses a device as claimed in claim 1, characterized by at least one means, in particular at least one coil arrangement, for changing the spatial position of the two part-areas in the examination area so that the magnetization of the particles changes locally (col. 13, ll. 9 – 14).

Regarding Claim 3 and 4, Kraus discloses device as claimed in claim 1, characterized in that the means for generating mechanical displacements or oscillations comprises at least one oscillating element ("implanted magnetic needle"), an oscillation generator ("magnet") and an oscillation transmission means for transmitting oscillations from the oscillation generator to the oscillating element and/or at least one sound source, in particular an ultrasound source; components are made of non-metallic and/or metallic material (col. 9, ll. 65 – 67; col. 3, ll. 52 – 60; col. 11, line 58 – col. 12, line 5).

Regarding claims 5 - 9, Kraus discloses relevant characterizations (see rejection of Claim 1; col. 9, line 23 – col. 10, line 64; col. 13, ll. 16 – 18; and col. 14, ll. 9 – 15).

Regarding Claim 19, Kraus discloses a use of the device as claimed in claim 1 for determining the internal pressure or the change in internal pressure of gas bubbles present in an examination object, in order to image body parts and/or organs (col. 6, ll. 41 – 67).

Regarding Claim 20, Kraus discloses a use of the device as claimed in claim 1 for examining, particularly in real time, tissue or organs, in particular respiratory organs (col. 6, ll. 46 - 48).

Conclusion

The following is prior art made of record, but not relied upon, is considered pertinent to applicant's disclosure:

US Pat 6,726,650 B2; Schneider et al.; "Automatic Liquid Injection System and Method"

US Pat 7,439,736 B2; Meaney et al.; "Imaging by Magnetic Resonance Adsorption, Elastography and Tomography."

US Pat 7,553,283 B2; Sandrin et al.; "Device and Method for Measuring Elasticity of a Human or Animal Organ and for Two-or-three-dimensional Representation Thereof."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANI GUPTA whose telephone number is (571)270-5042. The examiner can normally be reached on Monday - Friday (8:30 am - 5:30 pm; EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. G./
Examiner, Art Unit 3768

/Long V Le/
Supervisory Patent Examiner, Art Unit 3768